

**REMARKS**

Applicants appreciate the Examiner's attention to the above referenced application. Reconsideration of the application is respectfully requested based on the foregoing amendments and following remarks. Claims 1-9, 11-25 and 27-32 were rejected. Claims 10 and 26 remain cancelled. Claims 1, 5, 11-12, 17, 21, and 27-28 have been previously amended. Claims 1-9, 11-25 and 27-32 are now pending, of which Claims 1 and 17 are independent.

**§103 Rejection of the Claims**

Claims 1, 9, 11, 12, 16, 17, 25, 27, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub. No. 2004/0215544 to Formale et al. (hereinafter, "Formale") in view of U.S. Pub. No. 2003/0233277 to Saunders et al., (hereinafter, "Saunders"). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

The Examiner admits that Formale fail to disclose waitlisting surplus items. However, the Examiner relies on Saunders for this limitation, specifically, Para. [0003]. This assertion is faulty for several reasons.

Claims 1 and 17 require notifying, by the tool, the employee who waitlisted the item that the surplus item has been put on reserve and enabling the employee to order the item within a first predetermined time period. The Examiner relies on Para. [0003] of Saunders. However, Saunders teach a method of enabling a customer (not an employee) to place a raincheck on the item. The method described is for an employee to place a physical piece of paper (raincheck form) in an actual shelf or physical location where the product should be. The customer must then fill out the raincheck form and return it to the employee. When the product arrives at the store, the physical raincheck is affixed to the product and the store waits for the customer to return with their copy of the raincheck. If the customer does not return to the store, the product may be put back into the general stock.

There is no teaching or suggestion in the cited reference (Para. [0003]) that the desired user of the item (customer) can use a web-based tool to request an item, or that the web-based tool notifies the customer that the item has been put on reserve. A physical raincheck system

that requires both the customer and a store employee to fill out and file paperwork, or a method that requires the customer to return to the store to determine whether the item has been reserved cannot be combined with Formale to result in the claimed invention. Even in a case where the employee calls the customer to alert them that the product has been put on reserve does not describe the claimed waitlisting method. Thus, using Para. [0003] to show the claimed waitlisting limitation is improper and this rejection should be withdrawn.

Moreover, Applicant has reviewed Saunders as a whole and found no teaching or suggestion that the described rainchecking system could be used as claimed and described by Applicant, even if combined with Formale. As discussed in the Amendment previously submitted, Claims 1 and 17 require a web-based tool configured to select a disposition path, where the disposition path can be selected as any one of *scrapping the surplus item, donating the surplus item, reselling the surplus item, refurbishing the surplus item for reuse, and enabling reuse of the surplus item within the company*. Claims 1 and 17 also require that when the disposition path is enabling reuse of the surplus item within the company, that the web-based tool compares the surplus item to items waitlisted by employees of the company.

Neither Formale nor Saunders teach this limitation. As admitted by the Examiner, Formale does not teach or suggest waitlisting items. The Examiner relies on the teachings of Saunders for this limitation. However, Saunders teaches a method for a retail merchant to provide rainchecks to customers who have typically entered the retail store, only to find that the item is unavailable. The customer must have a store employee enter the raincheck information into the database in order for the raincheck to be activated. The store employee may also alert the customer to viable alternatives to the desired item, at that time. The Examiner misunderstands who the end user of the web-tool is.

To compare the teachings of Saunders with the claimed invention, the Examiner equates the employee recited in the claim to the employee of the retail store in Saunders. This is incorrect. In Saunders, the person desiring to purchase the item is the *customer*, and not a store *employee*. Further, as taught by Saunders, the item will not be used within the company. Claims 1 and 17 clearly recite “enabling the reuse of the surplus item within the company.” Moreover, Applicant’s invention contemplates the reuse of an item, where Saunders is for the purchase of new items in a retail store. Thus, there is no motivation to combine the teachings of Saunders

with Formale because there is no contemplation that the raincheck system of Saunders could be used within a company to reserve surplus items for reuse, by an employee of the company and to be again used within the company.

The claimed invention requires that a web-based tool is used for selecting the disposition of a surplus item, by a direct user. The store employee of Saunders is not a direct user of the item. Claims 1 and 17 also recite that the web-based tool is for managing used assets. The raincheck system of Saunders is for managing rainchecks or new items to be purchased by a customer. The claimed web-based tool allows the company to select one of a number of disposition paths for the used surplus item. When that disposition is reuse, or reassignment of the used item, the web-based tool compares the item description with previously waitlisted items, where the items have been waitlisted by an employee. Claims 1 and 17 also require that the reuse is to be within the company. This is contrary to the teachings of Saunders. Further, the employee is notified, by the tool, that the item has been put on reserve. The Saunders raincheck system may automatically notify a customer, but not the employee, when the item has been restocked. Thus, the Examiner relies on the term “employee” when it is convenient, and relies on the term “customer” when it is convenient. However, in Saunders, the employee and customer are not the same person, nor is there a link of the customer to the company, as required by the recited claim. Thus, the Examiner is using faulty assumptions and the rejection is improper.

It will be apparent to those with skill in the art that the Saunders raincheck system solves a different problem than the asset management system of Formale. There is no motivation to combine these methods because they solve different problems. Formale is for managing used corporate assets, and Saunders is for managing out of stock, new, retail assets. Management of used corporate assets requires a different methodology than managing new items for retail purchase, and therefore, combining these references is counterintuitive.

Moreover, a combination of the teachings of Formale and Saunders will not result in the claimed invention, because all limitations are not taught or suggested. As discussed above, Saunders does not provide a method to waitlist a desired surplus, used company owned item, by an employee of the company. Saunders does not place a reusable item in an on-line catalogue to allow an employee to order the surplus item, where the item remains in the catalogue for a

predetermined time. Moreover, Saunders does not enable the direct user of the used, surplus item to enter it into an active items list. Instead, Saunders requires a customer to request a raincheck of an employee, who enters the raincheck information into the database. Neither the employee, nor the customer, are direct users of the item, at least because the item is a new retail item, and not a surplus company asset designated for reuse within the company.

Claims 1 and 17 also require that the surplus item is to be ordered by an employee, for use within the company, and not for personal use. Saunders does not teach or suggest this sort of waitlisting (raincheck) system. Instead, Saunders teach a system for waitlisting items for personal use, by a customer. The methodology used in Formalc and Saunders to manage assets or products are very different. Because they are directed to such different results, combination of the methodologies would not be obvious to one of skill in the art. Therefore, there is no *prima facie* evidence of obviousness, and this rejection should be withdrawn.

Moreover, the Examiner's reasoning for the rejection is improper and it should be withdrawn on those grounds alone. In the Response to Arguments (beginning on Page 14 of the Office Action), the Examiner asserts that the limitation of managing *used* assets is "considered non-functional descriptive material." This is improper use of this type of argument/rejection. Non-functional Descriptive material may be grounds for non-statutory subject matter (§ 101) type of rejection. However, it is not relevant for an obviousness-type rejection (§ 103). See MPEP § 2106.01 Computer-Related Nonstatutory Subject Matter, for a discussion on the use of non-functional descriptive material.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 for Exemplary rationales that may support a conclusion of obviousness:

- “(A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.”

However, the Examiner provides no reasoning as to why the claim, as recited, is obvious, except to say that “the web-based managing used assets are considered non-functional descriptive material. The fact that the assets are *used* does not change the function of the claimed invention in Claims 1 and 17.” [emphasis added] But, as discussed above, use of the term “non-functional descriptive material” is improperly used for as a § 103 rejection. Further, Applicants assert that managing *used* assets is different than managing new assets, as shown by the different use cases (scenarios) in Saunders’ waitlisting method. As discussed above, Formale and Saunders provide solutions to different types of problems, in different functional manners. Thus, this rejection should be withdrawn.

As for Claims 12 and 28, the Examiner once again confuses the difference between the employee and the customer. The Examiner asserts that Saunders teach that the surplus item is removed from reserve if the employee does not order the item. However, Saunders teach that if the customer does not come back for the new item that the item is removed from reserve. There

is a distinction in the recited claims that requires the surplus item to be removed from reserve if the employee does not order the item. The employee, here, cannot be equated with the customer, because presumably, the customer is not planning to use the item within the company, but to take it home with him/her, after purchase.

As for Claims 16 and 32, the Examiner once again confuses the difference between the employee and the customer. Further, the Examiner continues to cite the description in Para. [0003] of Saunders which describes a paper raincheck system. Moreover, the Examiner asserts that Saunders (in Para. [0003]) teach that some employee who waitlisted an item is given a priority. However, this limitation cannot be found in Para. [0003]. Thus, rejection is improper and should be withdrawn.

As for Claims 11 and 27, the Examiner once again confuses the difference between the employee and the end customer, and use within the company. Formale, in the cited reference (Para. [0036-0037]) allows an employee to purchase an item for personal use (Para. [0035]) after a predetermined time listed as surplus. The item may be listed as scrap after being listed as a surplus item for a predetermined time, or be available for trade-in. However, Claims 11 and 27 require *"removing the surplus item from the on-line public catalogue for re-evaluation."* [emphasis added] Formale teach a system for keeping an asset in a specific category for a predetermined time prior to changing categories, such as SCRAPPED. However, Formale do not teach or suggest a re-evaluation of the asset, as required by Claims 11 and 27.

Claims 9 and 25 are believed to be allowable at least by being dependent on an allowable base claim.

Claims 2-4, 6, 18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale in view of Saunders, and further in view of the Examiner's Official Notice. Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein. Claims 2-4, 6, 18-20 and 22 are dependent on an allowable base claim, as described above.

As for Claims 2 and 18, the Examiner takes Official Notice that scrapping an item is well known and can be combined with Formale and Saunders. However, scrapping items is inconsistent with the purchase of new, retail items, as taught by Saunders. Thus, a combination

or Formale and Saunders, especially with the Official Notice, is counter-intuitive. Thus, it would not be obvious to combine these references, even with Official Notice, as it is not obvious that one would want to scrap a new, retail product because a customer has not purchased it within a time period. Further, new items have not lost their inherent value, as required in a decision to scrap the item. Thus, this rejection should be withdrawn.

As for Claims 3 and 19, the Examiner takes Official Notice that donating an item is well known and can be combined with Formale and Saunders. However, donating items is typically inconsistent with the purchase of new, retail items, as taught by Saunders. Thus, a combination or Formale and Saunders, especially with the Official Notice, is counter-intuitive. Thus, it would not be obvious to combine these references, even with Official Notice, as it is not obvious that one would want to donate a new, retail product because a customer has not purchased it within a time period. Further, new items have not lost their inherent value, as required in a decision to donate the item. Thus, this rejection should be withdrawn.

As for Claims 4 and 20, the Examiner takes Official Notice that selling an item to a third party is well known and can be combined with Formale and Saunders. However, selling items to a third party is typically what Saunders is already trying to do. However, Saunders teach selling new, retail items. Thus, it is inconsistent to assume that the new items would suddenly become surplus and an additional decision required to sell them to a third party. Saunders does not teach surplus items. Thus, a combination or Formale and Saunders, especially with the Official Notice, is counter-intuitive. Thus, this rejection should be withdrawn.

As for Claims 6 and 22, the Examiner takes Official Notice that reusing an item within the company is well known and can be combined with Formale and Saunders. However, reusing an item is counter to the teachings of Saunders. Saunders teach selling new items to a third party, where those items were never to be used within the company to begin with. Thus, the reuse of items within the company is inconsistent to assume that the new items would suddenly become surplus, but could be reused within the company. Thus, a combination or Formale and Saunders, especially with the Official Notice, is counter-intuitive. Thus, this rejection should be withdrawn.

Claims 5 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale in view of Saunders and in further view of USPN 5,424,944 to Kelly et al. (hereinafter, “Kelly”) and Examiner's Official Notice. Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein. Claims 5 and 21 are dependent on an allowable base claim, as described above.

As for Claims 5 and 21, the Examiner takes Official Notice that reusing an item within the company is well known and can be combined with Formale, Saunders and Kelly. However, refurbishing an item is counter to the teachings of Saunders. Saunders teach selling new items to a third party, where those items were never to be used within the company to begin with. Thus, the reuse of refurbished items within the company is inconsistent with Saunders. These references are improperly combined. Thus, a combination of Formale, Saunders and Kelly, especially with the Official Notice, would be counter-intuitive. Therefore, this rejection should be withdrawn.

Claims 7 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale in view of Saunders and in further view of U.S. Pub. No. 2004/0117287 to Wang (hereinafter, “Wang”). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein. Claims 7 and 23 are dependent on an allowable base claim, as described above.

Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale in view of Saunders and in further view of U.S. Pub. No. 2002/0032626 to DeWolf et al. (hereinafter, “DeWolf”). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein. Claims 8 and 24 are dependent on an allowable base claim, as described above.

Claims 13 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale in view of Saunders, and further in view of USPN 5,870,717 to Wiecha (hereinafter, “Wiecha”) and U.S. Pub. No. 2003/0158791 to Gilberto et al. (hereinafter, “Gilberto”). This



rejection is moot based on the above amendments and foregoing discussion, at least as related to amended Claims 1 and 17, and should be withdrawn.

With regard to Claims 13 and 29, the Examiner asserts that Gilberto teach “notifying the employee that the surplus item has been shipped,” However, Gilberto teach a system including a buyer, seller and supplier. Applicants’ claimed invention is a method and system with only two parties: the employer (supplier) and employee (buyer). Thus, it would be counter-intuitive to utilize the method as taught by Gilberto with Formale, Saunders and Wiecha

Claims 14, 15, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Formale in view of Saunders, Wiecha and Gilberto, and in further view of U.S. Pub. No. 2003/0233243 to Officer (hereinafter, “Officer”). This rejection is moot based on the above amendments and foregoing discussion, at least as related to amended Claims 1 and 17, and should be withdrawn.

**CONCLUSION**

Applicants respectfully request reconsideration in view of the remarks set forth above. If the Examiner has any questions, the Examiner is encouraged to contact the undersigned at 703-633-6845. Please charge any shortage of fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-0221 and please credit any excess fees to such account.

Respectfully submitted,

Dated: 7 Apr. 2009 \_\_\_\_\_

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